

### **REMARKS**

Pursuant to the present amendment, claims 1, 15 and 26 have been amended, claims 8-13, 20-25 and 30-31 have been canceled, and claims 32-41 have been added. Thus, claims 1-7, 14-19, 26-29 and 32-41 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested.

Pursuant to the present amendment, claims 8-13, 20-25 and 30-31 have been canceled as they are directed to a non-elected invention that was the subject of a previous restriction requirement. Applicants specifically reserve the right to pursue the subject matter defined by the canceled claims in a later filed application should they so desire.

In the Office Action, claims 3, 4, 6, 7, 14, 17, 18, 19, 28 and 29 were indicated to be allowable if rewritten in independent form. Office Action, p. 3. Pursuant to the present amendment, new independent claims 32, 33, 34, 35, 36, 37, 38, 39 and 40 have been added to present dependent claims 3, 4, 6, 7, 14, 17, 18, 19 and 28, respectively, in independent form. Thus, it is believed that new claims 32-41 are in condition for immediate allowance.

In the Office Action, claims 1, 2, 5, 15, 16, 26 and 27 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Brugman (U.S. Patent No. 6,192,680). Applicants respectfully traverse the Examiner's rejection.

As the Examiner well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency requires that the asserted proposition necessarily flow from the disclosure. *In re Oelrich*, 212

U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Oelrich*, at 326, quoting *Hansgirg v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Skinner*, at 1789, citing *Oelrich*. Where anticipation is found through inherency, the Office’s burden of establishing *prima facie* anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Skinner* at 1789.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35

U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

Pursuant to the present amendment, claim 1 has been amended to specifically recite that the actuator device that is coupled to the first hydraulic cylinder is positioned in the environment that is at a pressure other than atmospheric, i.e., it is positioned in the same environment as the first hydraulic cylinder. Independent claim 15 has been amended to specifically recite that the actuator device that is coupled to the first hydraulic cylinder is positioned subsea. Similar amendments have been made to independent claim 26. As thus amended, it is respectfully submitted that claims 1-7, 14-19, 26-29 and 32-41 are in condition for immediate allowance.

In rejecting the pending claims, the Examiner identified the item 13 in Brugman (see Figure 1) as the first hydraulic cylinder, items 30 and 31 as an actuator device, item 28 as the isolated supply, item 44 as the hydraulic line intermediate the first hydraulic cylinder and the hydraulic actuator (R, H). Office Action, p. 2.

Applicants respectfully disagree with this reading of Brugman for a variety of reasons. Brugman identifies the various components referenced by the Examiner as follows: item 13 as the housing of a subsea hydraulic fluid storage vessel 12 (Col. 4, ll. 2-34); item 30 as a conventional pump and item 31 as an accumulator, both of which are expressly stated to be at the surface (Col. 4, ll. 44-53); item 28 is identified as a fluid supply line; items R and H are identified as a rod and housing, respectively (Col. 4, ll. 15-23).

In Brugman, one end of the housing 13 is open to the surrounding seawater. The hydrostatic pressure of the surrounding seawater is applied to the piston 16 to thereby transmit the hydrostatic head of the seawater to the hydraulic fluid 24. Thus, the pump 30 and accumulator 31 is not an actuator device that is adapted to drive the first cylinder to create said sufficient pressure in the fluid, as recited in claim 1. The purpose of the pump 30 and accumulator 31 is to supply and resupply hydraulic fluid to the subsea fluid storage vessel 12. Col. 4, ll. 44-53. In Brugman, it is the hydrostatic head of the seawater that creates the pressure in the hydraulic fluid in the storage vessel 12. For at least this reason, it is respectfully submitted that the Examiner's rejection of independent claims 1, 15 and 26 is improper and should be withdrawn.

Moreover, pursuant to the present amendment, independent claims 1, 15 and 26 have been amended to specifically recite that the actuator device (claims 1 and 15) and first hydraulic cylinder (claim 26) are positioned in the environment that is at a pressure other than atmospheric

(claim 1) or subsea (claims 15 and 26). This further distinguishes the currently pending claims from Brugman. In Brugman, the pump 30 and accumulator 31, which the Examiner identified as the actuator device, are specifically described as being positioned at the surface. For at least this additional reason, claims 1-7, 14-19, 26-29 and 32-41 are believed to be in condition for immediate allowance.

In view of the foregoing, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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